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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,419	12/07/2001	Oswin Ottinger	SGL 00/9	2778

7590 03/23/2005

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EXAMINER

FEELY, MICHAEL J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,419

Applicant(s)

OTTINGER ET AL.

Examiner

Michael J. Feely

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16, 18-30 and 36-61 is/are allowed.
- 6) ☒ Claim(s) 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Pending Claims

Claims 1-16 and 18-61 are pending.

Previous Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. The rejection of claims 1-6, 13-16, and 22-24, under 35 U.S.C. 102(e) as being anticipated by Woods (US Pat. No. 6,656,580) and Technical Data Sheets for Resinol 90C and Resinol RTC, provided by Loctite, has been overcome by amendment.
3. The rejection of claims 31-33 and 35 under 35 U.S.C. 102(e) as being anticipated by Woods (US Pat. No. 6,656,580) and Technical Data Sheets for Resinol 90C and Resinol RTC, provided by Loctite, stands. ***These claims have been amended; however, the prior art still anticipates the claimed invention.***

Normally, only one reference is used for a rejection under 35 U.S.C. 102; however, the use of multiple references is proper when the extra references are cited to: A) Prove the primary reference contains “enabled disclosure;” B) Explain the meaning of a term used in the primary reference; or C) Show that a characteristic not disclosed in the reference is inherent. In the instant case, Technical Data sheet are used to show inherent characteristics of the acrylic resin used in Woods.

Regarding claims 31-33, Woods (*with support of the Technical Data Sheets*) discloses, **(31)** a sealing element (column 4, lines 11-17), **(32)** a fuel cell component (column 4, lines 11-17), and **(33)** a heat conducting element (column 4, lines 11-17; *inherently capable of conducting*

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heat) comprising a synthetic resin-impregnated body (column 4, lines 40-47) comprising a primary product formed of expanded or at least partially recompressed expanded graphite having a liquid-accessible pore system (column 4, line 50 through column 5, line 5), wherein said primary product is impregnated (column 5, lines 20-35) with at least one of: at least one solvent-free polymerizable acrylic resin system (column 5, lines 5-10; column 9, lines 45-56; Technical Data Sheets for Resinol 90C and Resinol RTC) *{(for 31 & 32) including triethyleneglycol dimethacrylate (column 9, lines 45-56) and at least one azo initiator (column 10, line 37 through column 11, line 38)}*; and polymers obtained by curing said at least one resin system (column 5, lines 5-10; column 9, lines 45-56; Technical Data Sheets for Resinol 90C and Resinol RTC).

Claim 35 introduces an intended use limitation to the invention of claim 32. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In the instant case, the intended use of *using oxygen as an oxidant* does not result in a structural difference between the claimed invention and the prior art. The claimed fuel cell is capable of performing the intended use; therefore, it meets the claimed limitations.

Previous Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. The rejection of claims 7-9, 19-21, and 25-29 under 35 U.S.C. 103(a) as being unpatentable over Woods (US Pat. No. 6,656,580) and Technical Data Sheets for Resinol 90C and Resinol RTC, provided by Loctite, has been overcome by amendment.

Previous Claim Rejections - 35 USC § 102/103

6. The rejection of claims 11 and 12 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Woods (US Pat. No. 6,656,580) and Technical Data Sheets for Resinol 90C and Resinol RTC, provided by Loctite, has been overcome by amendment.

7. The rejection of claim 34 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Woods (US Pat. No. 6,656,580) and Technical Data Sheets for Resinol 90C and Resinol RTC, provided by Loctite, stands.

Regarding claim 34, Woods does not explicitly disclose a gas permeability of from 0.001 to 0.016 mg/m²*s; however, this gas permeability would have been an inherent property of Woods' invention. The resin-impregnated body of Woods contains the same materials as the instant invention. In light of this, it has been found that, "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore if the prior art teaches the identical chemical structure, the

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properties applicant discloses and/or claims are necessarily present – *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Therefore the product of Woods would have inherently had a gas permeability of from 0.001 to 0.016 mg/m²*s because the materials used are the same as those used in the instant invention.

Previous Claim Objections

8. The objection to claim 17 has been rendered moot by the cancellation of claim 17.

Allowable Subject Matter

9. Claims 1-16, 18-30, and 36-61 are allowed.

10. The following is a statement of reasons for the indication of allowable subject matter: claims 10, 17, 18, and 30 are allowable for the reasons set forth in the previous Office action:

- Regarding claims 10 and 30, Woods provides no motivation to include fillers in the porous graphite sheet. Claims 36-47 are allowed because they are dependent from claim 10, and claims 49-61 are allowed because they are dependent from claim 30.
- Regarding claims 1, 14, and 18, Woods is silent regarding the ash value of porous graphite, and the prior art fails to shed light on the ash value of these materials. Furthermore, Applicants discuss criticality of the ash value on pages 16-17 of the Specification. Claims 2-13 and 48 are allowed because they are dependent from claim 1, and claims 15, 16, and 19-29 are allowed because they are dependent from claim 14.

Response to Arguments

11. Applicant's arguments filed July 15, 2004 have been fully considered but they are not persuasive.

- Claims 31 and 32 (*see page 22*): Applicants simply state that Woods does not satisfy the claimed limitations; however, this is not the case – *see rejection above*.
- Claim 33 (*see page 22*): Applicants argue that Woods is silent regarding the function of graphite plate a heat conducting element; however, it appears that this graphite plate would have been inherently capable of functioning as a heat conducting plate.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

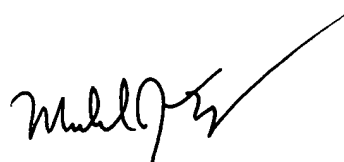
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Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely
Primary Examiner
Art Unit 1712

March 21, 2005